

## ***REMARKS***

Applicant thanks the Examiner for his courtesy in reviewing the cited references and the specification with Applicant's attorney. As a gentle reminder, Applicant respectfully requests consideration of Applicant's 1.132 declaration filed on November 3, 2003.

### ***I. Rejections under 35 U.S.C. § 103***

The Examiner has rejected claims 9, 11-12, and 24-36 as being unpatentable over Simpson et al. (5,096,759) in view of Harkness (4,775,567), Diamond (4,194,335), and Zickell et al. (4,992,315) patents. In rejecting these claims, the Examiner concludes that it would have been obvious to modify the article of manufacture of Simpson with the teachings of Harkness, Diamond, and Zickell. Applicant respectfully disagrees for the reasons set forth below.

### **A. THE OFFICE ACTION ENGAGES IN IMPERMISSIBLE HINDSIGHT**

Although the Office Action does provide some reasoning why the cited references could be combined, the Office Action fails to state why one of ordinary skill in the art at the time of invention would seek such a combination. The phrase "at the time of invention" guards against entry into the "tempting but forbidden zone of hindsight" when analyzing the patentability of claims. *Locite Corp. v. Ultraseal Ltd*, 228 USPQ90, 98 (Fed. Cir. 1985), overruled on other grounds by *Nobelpharma AB v. Implant Innovations, Inc.*, 46 USPQ2d 1097 (Fed. Cir. 1998).

As stated by the United States Court of Appeals for the Federal Circuit:

The genius of invention is often a combination of known elements which in hindsight seems preordained. To prevent hindsight invalidation of patent claims, the law requires some "teaching, suggestion or reason" to combine cited references . . . When the art in question is relatively simple, as is the case here, the

opportunity to judge by hindsight is particularly tempting. Consequently, the tests of whether to combine references need to be applied rigorously.

*McGinley v. Franklin Sports, Inc.*, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001).

In this case, the Examiner has used the present invention with hindsight construction to selectively incorporate certain features from Simpson that may be combined with Harkness, Zickell, and Diamond. “The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992). “It is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious.” *Id*; see also *Para-Ordnance Mfg. v. SGS Importers Int'l.*, 73 F.3d 1085, 1087 (Fed. Cir. 1995)(“Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor.”). In following the teachings of the present invention to combine the prior art references, the Examiner fails to appreciate the differences between the present invention and the teachings set forth by Simpson, Harkness, Zickell, and Diamond, including some features that are important and necessary to the invention disclosed by Simpson and Zickell, such as the adhesive release sheet, or the differences of the invention that Diamond discloses, such as the vapor barrier and shingle courses. Additionally, the Examiner fails to consider the present invention overall in comparison to the differences of Simpson, Harkness, Zickell, and Diamond that teaches away from the present invention.

**B. PRIOR ART MUST BE CONSIDERED IN ITS ENTIRETY, INCLUDING  
DISCLOSURES THAT TEACH AWAY FROM THE CLAIMS**

A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983). In this case, the Diamond, Simpson and Zickell references teach away from the claimed invention.

The Diamond reference teaches away from the present invention for four reasons. First, Diamond teaches conventional roof construction in a preassembled form. As noted on page 1, lines 26-30, of Applicant's Specification, "Most overlaid shingled roofs are not designed to seal against the standing water caused by ice dams. They are designed, through their overlaid placement, to seal against water running off the roof. When water stands on a pitched shingled roof, the water seeps under the shingles, through the sheathing and into the structure." The present invention avoids the problems of conventional roof construction by providing a vapor, water and ice resistant layer for the prevention of damages caused by ice dams. Diamond does not teach or suggest a pre-assembled structure for the prevention of water seeping under the shingles and into the structure. Instead, Diamond teaches an article designed to seal against water running off the roof.

Second, Diamond places great emphasis on the fact that his invention "allows for fastening at any point simply by lifting any single tab on its surface area." See col. 1, lines 58-67. Applicant's invention avoids the problems described by Diamond by assembling the shingles after installation of the sheathing panels. Further, the invention disclosed by Diamond is problematic in that it takes a considerable amount of time to lift each shingle tab before securing the panel. In contrast, Applicant's invention avoids the problems disclosed by Diamond and the

problems of the Diamond reference itself by assembling the shingles after assembling the sheathing panels.

Third, Diamond teaches the use of a vapor barrier (item #20). As noted in Applicant's Specification on page 2, lines 16-17, "The vapor barrier is not effective in precluding leakage caused by ice dams." Applicant's invention eliminates the typical vapor barrier and prevents water damage caused by ice dams.

Fourth, Diamond teaches that the entire roof should be covered by the prefabricated roof panel in various courses. In contrast, Applicant's invention is not applied to the whole roof but along the eaves, or edge of a roof. Note that claim 9 states, "for reducing water and ice damage on an edge of a roof." Additionally, independent claims 26, 31, and 36 have been amended to clarify that the preassembled panels are installed adjacent the eaves of the roof. This claim limitation is supported by Applicant's Specification on page 7, lines 26-28.

Further, the present invention avoids the complexity of installing the panels in courses. In cols. 5 and 6, Diamond teaches a complex and cumbersome method of assembling various courses on the roof. The various courses are necessary to achieve the "interlocking, interwoven relationship of the shingles across the abutted ends of the respective panel . . ." Col. 5, lines 9-11. Applicant's invention eliminates such complexity. Applicant's invention allows for installation of the preassembled article and subsequent installation of overlapping shingles in the traditional manner. Thus, Applicant's invention provides a preassembled article that prevents damage caused by ice dams and allows for rapid installation of *both* the sheathing panels and the shingles.

The Simpson reference also teaches away from Applicant's invention. Simpson teaches the use of rolls. See Fig. 1. The rolls are applied to the whole roof in overlapping parallel strips.

See Fig.2; see also col. 5, lines 65-67. In contrast, Applicant's claimed invention includes a prefabricated article that is applied along the eaves of a roof; it is not used to cover the whole roof. As noted above, independent claims 26, 31, and 36 have been amended to clarify the placement of the preassembled panels. Additionally, Applicant's invention does not allow for an overlap of the vapor, water and ice resistant layer. Thus, Applicant's invention is easier to install and requires less material.

Finally, the Zickell reference teaches away from Applicant's invention because, as is stated in col. 4, lines 42-44, the membrane 10 is designed to be placed upon sheathing panels that are installed in a conventional manner. In other words, the sheathing panels are installed on the roof, and subsequently the membrane is installed on the sheathing panels. As noted above, Applicant's invention avoids several problems associated with applying a membrane after installing sheathing in the conventional manner.

Moreover, both Simpson and Zickell suffer from the problems described by the Applicant on page 3, lines 11-30, and page 4, lines 1-3 of the Specification in that they each include an adhesive release sheet designed to be removed while standing on the roof. It is extremely difficult and hazardous to remove the release sheet from a vapor barrier or vapor, water, and ice resistant layer while standing on a roof as evidenced by the attached declarations. Applicant's claimed invention avoids the hazards presented by removing the release sheet while standing on the roof. Thus, Simpon and Zickell teach away from Applicant's invention by teaching the use of a release sheet.

Here, Applicant has recognized a problem in the art and provided a solution not taught or suggested by the cited references. In fact, Diamond, Simpson and Zickell references teach away from the claimed invention. As is clearly seen in the cited references, conventional thinking

provides a roofing system designed to allow water to run off the roof or to provide rolls of an overlapping vapor, water, and ice resistant layer while standing on the typical roof. None of the cited references teach or suggest the solution claimed by the applicant. For these reasons, Applicant courteously requests withdrawal of the claim rejections under 35 USC 103.

*Conclusion*

It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, he is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment is respectfully requested.

Respectfully submitted,

  
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